



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,509	12/19/2000	Masaki Ito	FUJ 17.715	7520

7590 04/28/2004
HELFGOTT & KARAS, P.C.
Empire State Building, 60th Floor
New York, NY 10118-0110

EXAMINER

YUSSUF, SAJID

ART UNIT	PAPER NUMBER
----------	--------------

2141

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/741,509

Applicant(s)

ITO ET AL.

Examiner

Sajid A Yussuf

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/19/2000-03/12/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5 / 03/12/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been received.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. ***Claim(s) 1-8 is/are rejected under 35 U.S.C. 102(e) as being anticipated by Nixon et al. (US Patent No. 6,513,060 and Nixon hereinafter).***

6. As per claim(s) 1 Nixon discloses a monitoring unit which monitors each communicability state of terminals, detects a change between a current communicability

Art Unit: 2141

state of the terminals and a previous communicability state of the terminals, and generates monitoring results in accordance with detecting the change, (See Column 1 Lines 43-67); and a editing communication unit (i.e., control unit) which edits the monitoring results of the terminals and transmits edited monitoring results on a network, (See Column 3 Lines 41-54).

7. As per claim(s) 2 Nixon teaches the claimed invention as described in claim(s) 1 above and furthermore discloses the editing communication unit sets to incommunicable state a terminal that has been in incommunicable state for a period of time or longer (i.e., halting service), (See Column 4 Lines 43-50).

8. As per claim(s) 3 Nixon teaches the claimed invention as described in claim(s) 1-2 above and furthermore discloses a server wherein the editing communication unit edits the monitoring results of the terminals in e-mail format and transmits edited monitoring results to the server, (See Column 4 Lines 31-44).

9. As per claim(s) 4 Nixon teaches the claimed invention as described in claim(s) 1-3 above and furthermore discloses a World Wide Web server (i.e., web server) , wherein the communication editing unit edits the monitoring results of the terminals in tagged-text format and provides the edited monitoring results to the World Wide Web server as a file name including a date and/or time of day, (See Column 6 Lines 58-67 & Column 7 Lines 1-25).

10. As per claim(s) 5 Nixon teaches the claimed invention as described in claim(s) 1-4 above and furthermore discloses the server is an FTP (File Transfer protocol) server and the communication editing unit edits the edited monitoring results into table-format data and provides the edited monitoring results to the FTP server as a file name including date and/or time of day, (See Column 5 Lines 50-67 & Column 7 Lines 1-25).

Art Unit: 2141

11. As per claim(s) 6 Nixon teaches the claimed invention as described in claim(s) 1-5 above and furthermore discloses billing information corresponding to the communication executed by the terminals is included in the edited monitoring results, (See Column 13 Lines 20-30).

12. As per claim(s) 7 Nixon discloses a monitoring unit which monitors each communicability state of terminals and stores the communicability state in the monitoring unit, (See Column 1 Lines 43-67); and an agent reception (i.e., control unit) and transfer unit which, when at least one terminal is in an incommunicable state detected by the monitoring unit, the agent reception and transfer unit receives e-mail instead of a user of a terminal that is in the incommunicable state and transfers the received e-mail to a desired transfer destination; wherein it control the report unit which is in turn in charge of sending e-mails, (See Column 5 Lines 27-40).

13. As per claim(s) 8 Nixon teaches the claimed invention as described in claim(s) 7 above and furthermore discloses the agent reception and transfer unit which receives e-mail instead of the user, including one or more prescribed characters in a title of the received e-mail, and transfers the received e-mail to the desired transfer destination, (See Column 7 Lines 1-25).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2141

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.
Ascertaining the differences between the prior art and the claims at issue.
Resolving the level of ordinary skill in the pertinent art.
Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. *Claims 9 & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nixon et al. (US Patent No. 6,513,060 and Nixon hereinafter) in view of Fuisz et al. (US Patent No. 6,389,455 and Fuisz hereinafter).*

17. As per claim 9 Nixon discloses the claimed invention as described above.

However, Nixon does not explicitly teach the prescribed characters are included in the title of the e-mail, the agent reception and transfer unit sets the e-mail to be in unread state.

Fuisz teaches if the prescribed characters are included in the title of the e-mail, the agent reception and transfer unit sets the e-mail to be in unread state, (See Fuisz Column 4 Lines 57-67 & Column 5 Lines 1-10).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Nixon with the teachings of Fuisz to include the prescribed characters are included in the title of the e-mail, the agent reception and transfer unit sets the e-mail to be in unread state with the motivation to provide for a User sending an e-mail from a secondary account (e.g. corporate intranet account etc), the possibility exists that the recipient will respond utilizing the "reply" command. To ensure that such "replies" are routed through the bounce system, users may address outgoing e-mail to a special forwarding address and embed the ultimate address in a non-address portion of the e-mail (e.g. the re: line, to line, from line, cc line, bcc line, etc.). Upon receipt of the e-mail the bounce system (i) identifies and strips the embedded address from the e-mail and (ii) identifies the primary account of the user. The bounce system then

Art Unit: 2141

forwards the e-mail content to the ultimate addressee, in the form of an e-mail from the user's primary account. If the recipient chooses to "reply" to this e-mail, such response will be routed through the bounce system, (See Fuisz Column 2 Lines 28-43).

18. As per claim(s) 10 Nixon discloses the claimed invention as described above.

However, Nixon does not explicitly teach an e-mail address of the transmission origin of the e-mail before the e-mail is received agrees with the e-mail address used by the agent reception and transfer unit, the agent reception and transfer unit sets the e-mail to be in unread state.

Fuisz teaches an e-mail address of the transmission origin of the e-mail before the e-mail is received agrees with the e-mail address used by the agent reception and transfer unit, the agent reception and transfer unit sets the e-mail to be in unread state, (See Fuisz Column 5 Lines 60-67 & Column 6 Lines 1-22).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Nixon with the teachings of Fuisz to include an e-mail address of the transmission origin of the e-mail before the e-mail is received agrees with the e-mail address used by the agent reception and transfer unit, the agent reception and transfer unit sets the e-mail to be in unread state with the motivation to provide for a User sending an e-mail from a secondary account (e.g. corporate intranet account etc), the possibility exists that the recipient will respond utilizing the "reply" command. To ensure that such "replies" are routed through the bounce system, users may address outgoing e-mail to a special forwarding address and embed the ultimate address in a non-address portion of the e-mail (e.g. the re: line, to line, from line, cc line, bcc line, etc.). Upon receipt of the e-mail the bounce system (i) identifies and strips the embedded address from the e-mail and (ii) identifies the primary account of the user. The bounce system then forwards the e-mail content to the ultimate addressee, in the form of an e-mail from the user's primary account. If the recipient chooses to "reply" to this e-mail, such response will be routed through the bounce system, (See Fuisz Column 2 Lines 28-43).

Art Unit: 2141

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Choe et al. (US Patent No. 6,584,504) discloses method and apparatus for monitoring Internet traffic on an Internet web page;

Klassen et al. (US Patent No. 6,711,137) discloses a system and method for analyzing and tuning a communications network;


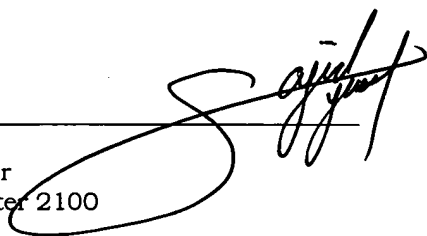
Phaal et al. (US Patent No. 5,315,580) discloses a network monitoring device and system;

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sajid A Yussuf whose telephone number is (703) 305-8752. The examiner can normally be reached on Monday-Thursday 7:30-5:00 PM and Alternate Fridays.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

22. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Sajid Yussuf
Patent Examiner
Technology center 2100
26 April 2004



RUPAL DHARIA
SUPERVISORY PATENT EXAMINER